

REMARKS

Claims 1, 3-5, 9-25 and 32 are pending in the present application. Claims 2, 6-8, 16-19, 22, 26-31 and 33-45 have been previously canceled without prejudice or disclaimer.

Applicants, by previously canceling or amending any claims, make no admission as to the validity of any rejection made by the Examiner against any such claims. Applicants reserve the right to reassert any of the claims canceled and/or the original claim scope of any claim amended, in a continuing application.

No new matter has been added.

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

I. Telephone Conference/Interview

Applicants thank Supervisory Examiner Lundgren for conducting a telephone conference/interview with Applicants' undersigned representative regarding the requirement for restriction in this application. As agreed during the telephone conference/interview, all of the presently pending claims will be examined on the merits pursuant to a formal request for the same in response to the outstanding Restriction Requirement. Applicants thank SPE Lundgren for this indication and submit herein a formal request that the restriction requirement be withdrawn.

II. Restriction Requirement

In the outstanding Official Action, the Examiner has required restriction of claims 1, 3-5, 9-25 and 32 to a single invention under 35 U.S.C. §§ 121 and 372. Claims 1, 3-5, 9-25 and 32 were subjected to a restriction requirement as follows:

- Group I - claims 1, 3-5, 9-11, 21, 23, 24 and 25 drawn to a method of treating an inflammatory disease, an inflammatory disorder or a cancer selected from the list disclosed therein;
- Group II claims 12-15, drawn to a method for inhibiting cancer cell growth; and
- Group III claim 32, drawn to a combination of two pharmaceutical compositions.

III. Election

Applicants hereby provisionally elect claim 1, 3-5, 9-11, 21, 23, 24 and 25 of Group I, with traverse. Applicants note, however, that the election of Group I is solely to satisfy the formal requirement set forth in the Official Action. In this regard, Applicants note that, ***as already agreed, all of the pending claims will be examined on the merits upon submission of this paper.***

Applicants reserve the right to file a divisional application directed to the non-elected subject matter.

IV. TRAVERSAL

Applicants respectfully traverse this restriction requirement because each of the “Groups” of claims that the Examiner alleges are “unrelated” share a ***special technical feature*** under PCT Rule 13.2.

Further, MPEP § 803 specifies that restriction/election between two groups of claims is only proper when (1) one group of claims is independent **or** distinct from another group of claims and (2) a "serious burden" exists on the examiner in examining both groups of claims.

The Examiner can show a "serious burden" by establishing one of: the inventions are classified separately; the inventions have been classified together, but it can be shown that each subject has formed a separate subject for inventive effort (can cite patents or show a separate field of search); or the inventions require a separate field of search, that is, it is necessary to search for one subject in a place where no pertinent art for the other subject exists (MPEP § 808.02 (c)).

In the present application, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required between Groups I-III. See MPEP § 803. A complete and thorough search for the invention set forth in all of the alleged Groups would require searching the art areas appropriate to the other Groups. Since a search of each of the inventions of Groups I-III would be coextensive, it would not be a *serious* burden upon the Examiner to examine all of the claims in this application.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

CONCLUSION

Having made the required election, examination on the merits is earnestly solicited. Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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